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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,031	10/09/2001	Dale F. McIntyre	83194F-P	5074

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EXAMINER

HENDERSON, MARK T

ART UNIT	PAPER NUMBER
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3722

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/30/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No. 09/973,031	Applicant(s) MCINTYRE ET AL.	
	Examiner Mark T. Henderson	Art Unit 3722	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-33 is/are pending in the application.
- 4a) Of the above claim(s) 13-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-12 and 32 is/are rejected.
- 7) ☒ Claim(s) 33 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED OFFICE ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing or responses to Office Actions directly into the Group at (571) 273-8300. This practice may be used for filing papers, which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

1. Claim 4 has been amended for further examination. Claims 13-31 are withdrawn from further consideration.

Election/Restrictions

2. This application contains claims 13-31 drawn to an invention nonelected with traverse in Paper No. 10/4/2002. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3 and 12 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Bromer et al (5,445,417).

Bromer et al discloses in Fig. 1-7, an image product assembly comprising: a dual sided album leaf having a folded first ply layer (11a) and a second ply layer (11b), wherein each ply has an inner and an outer surface; wherein the ply layers are secured together (Col. 2, lines 60-65) to form a pocket (12) there between; wherein the first ply has a plurality of imaged indicia (ESKCO in Fig. 1, wherein each letter is considered an image; or 26 and 27 in Fig. 4); an insert (17 or 28) having a size and configuration such that it can be placed with the pocket (see Fig. 3); wherein the insert has information (29) that relates to the plurality of imaged indicia and is located in a position (between image 26) such that it can be readily identified with respect to the images (26); and wherein the information of the insert is correlated with respect to its associated image by providing a size of the associated of the associated image (thickness of decorative image (26) surrounding the information (29)) at a reduced size having reduced visual characteristics (wherein the thickness of image (26) is sized smaller than the thickness of the information

(letter) in order that an end user focus would be on the information (letters) rather than the images).

4. Claim 1, 4 and 12 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Liener Chin et al (6,632,042).

Liener Chin et al discloses in Fig. 22 and 27, an image assembly comprising a leaf (850) having a folded first ply layer (864) and a second ply layer (868) having an outer surface and an inner surface (see Fig. 22); wherein the ply layers are secured together to form a pocket there between; wherein the outer surfaces of the ply layers have a plurality of imaged indicia (854 and 858); an insert (890) having a size configuration such that it can be placed within the pocket; and wherein the insert has information indicia (884) on both surfaces (Col. 11, lines 30-36) that relates to the plurality of imaged indicia (854, and 858) and is located in a position (as seen in Fig. 27)) such that it can be readily identified with respect to the imaged indicia (854 and 858).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 4 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bromer et al in view of Liener Chin et al (6,632,042).

Bromer et al disclose an image assembly comprising all the elements as claimed in Claim 1, and as set forth above. However, Bromer et al does not disclose wherein the outer surface of the first and second ply has a plurality of imaged indicia which correlate with the information indicia on a first and second surface of the insert.

Liener Chin et al discloses in Fig. 22, a dual sided album leaf comprising: wherein the outer surfaces of the a first ply layer (864) and a second ply layer (868) has a plurality of images (854, and 858) which correlate to the information (884 and 894) printed on a first and second surface of the insert (Col. 11, lines 34-36).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bromer et al's album leaf with a images and information displayed on both sides of the album leaf as taught by Liener Chin et al for providing a means in which to display additional information.

6. Claims 5 and 6 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bromer et al in view of Fountain.

Bromer et al disclose an image assembly dual sided album leaf comprising all the elements as claimed in Claim 1, and as set forth above. However, Bromer et al does not disclose wherein the insert is provided with a retaining member.

Fountain discloses in Fig. 1 and 2, an image assembly comprising wherein an insert (10) is provided with a retaining member or restraining tabs (11).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bromer et al's image assembly with an insert having a restraining means as taught by Fountain for preventing the insert from being completely pulled out from between the two plies.

7. Claim 7 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bromer et al in view of Young.

Bromer et al disclose a image assembly comprising all the elements as claimed in Claim 1, and as set forth above. However, Bromer et al does not disclose wherein the insert is folded such that when it is placed in the pocket, the insert is retained.

Young discloses in Fig. 4, an assembly comprising a slidable foldable insert (32), wherein when the insert is placed in a pocket (as seen in Fig. 1-3), the insert is retained.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bromer et al's image assembly with a slidable folded insert as taught by Young for the purpose of retaining the insert within the ply pocket.

8. Claims 8-11 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bromer et al in view of Hawley.

Bromer et al disclose a dual sided album leaf comprising all the elements as claimed in Claim 1, and as set forth above. However, Bromer et al does not disclose: wherein the first and

second ply layers are adhesively secured along three sides of the four sides, wherein the adhesive is placed on two surfaces of a spacer, which is then placed between the ply layers.

Hawley discloses an image assembly comprising a spacer (6) having adhesive on both of its surfaces and placed between two ply layers (4 and 8).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Bromer et al's assembly with an adhesively placed spacer as taught by Hawley for the purpose of connecting the plies and forming a pocket having space for an insert.

9. Claim 32 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Bromer et al.

Bromer et al disclose a dual sided album leaf comprising all the elements as claimed in Claim 1, and as set forth above. However, Bromer et al does not disclose: providing an outline copy of the associated image on the insert.

In regards to **Claim 32**, Bromer et al discloses the claimed invention except for the specific arrangement and/or content of indicia (printed matter) set forth in the claim(s). It has been held that when the claimed printed matter is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an end user with a specific type of information document or form does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of

functional relationship necessary for patentability. The examiner asserts that the Bromer et al reference comprising an insert having image is the same structure claimed by applicant and the sole difference is in the content of the printed material. Thus, there is no novel and unobvious functional relationship between the printed matter (printed image) and the substrate (insert) which is required for patentability. Accordingly, there being no functional relationship of the printed material to the substrate, as noted above, there is no reason to give patentable weight to the content of the printed matter which, by itself, is non-statutory subject matter.

Allowable Subject Matter

10. Claim 33 is finally objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

11. Applicant's arguments filed on December 18, 2006 have been fully considered but they are not persuasive.

In regards to Applicant's arguments that there "are no images on the folder of Bromer et al", and that both the Bromer et al reference and the Liener Chin et al reference do not disclose information "that relates to a plurality of images on the outer surface of a ply layer of the dual-sided album leaf and is located in a position such that it can be readily identified", the examiner submits that the Bromer et al and the Liener Chin et al reference does indeed disclose images on the leaf (unsure as to what means when saying "folder" since this term is not stated in the claims) as clearly indicated in the above rejections.

In regards to applicant argument that the prior art does not disclose an insert having "a size and configuration that provides information with regard to the images formed on the outside", the examiner again submits both Bromer et al and Liener Chin et al does indeed disclose an insert having a size and configuration to be placed in a leaf and provides information with regard to images formed on the outer surface of the leaf as clearly indicated in the above rejections.

Therefore, the examiner has maintained the rejections above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3722

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3722

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477, and informal fax number is (571) 273-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Monica Carter, can be reached at (571) 272-4475. The formal fax number for TC 3700 is (571) 273-8300.



MTH

January 24, 2007



MONICA CARTER
SUPERVISORY PATENT EXAMINER